

REMARKS/ARGUMENTS

Claims 2-3 and 14 have been amended; claims 35-36 have been added and claims 1, 4-13 and 15-34 remain unchanged. Thus, claims 1-36 are pending.

Claims 1-8, 13, 20-21 and 27-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Office, Annual Technical Report "A Java Application Framework for Support Staff and epoline."

Claims 9 12, 14, 17-19 and 22-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO, MADRAS and USPTO, EAST.

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Formal Matters

The Examiner has cited several documents in the Notice of References Cited that Applicants request further clarification of in order to determine (1) which document is which and (2) which section of Section 35 U.S.C. §102 the documents are represented as prior art. Specific questions on documents listed in the Notice of References Cited are set forth below:

- Page 1/2: U - USPTO, eDAN: Applicants could not identify any document having this title. Also, the Examiner has not identified an effective date of the document.
- Page 1/2: V - EPO, Madras: Applicants assume this is a different document than either of the documents listed on Page 2/2 as document V (Bambridge) or document W (MADRAS screen shots) but could not identify any document having the recited title. Also, the Examiner has not identified an effective date of the document.
- Page 1/2: W - USPTO, EAST, figure East 1-4: Applicants assume this document is the four page document with a Post-It note on each page labeled "figure EAST 1", "figure EAST 2", "figure EAST 3", and "figure EAST 4", respectively. Applicants could not find any indication any of the four pages of this document as to its effective date. Clarification is requested. Applicants also note that the page labeled "figure EAST 1" seems to be identical to the page labeled "figure EAST 2". Clarification of this is requested also.
- Page 1/2: X - USPTO, WEST, figure WEST 1-2: Applicants assume this document is the two page document with a Post-It note on each page labeled "figure WEST 1"

and "figure WEST 2", respectively. Applicants could not find any indication any of the two pages of this document as to its effective date. Clarification is requested.

- Page 2/2: V - Bambridge, "A Java Application Framework for Support Staff and epoline (MADRAS)," version 1, pages 1-7: The document Applicants believe to be the Bambridge MADRAS document only has six pages, each labeled 1/6, 2/6 ... 6/6. Clarification is requested.
- Page 2/2: W - MADRAS screen shots, attached pages 1-4: Applicants could not identify any document having this title. Also, the Examiner has not identified an effective date of the document.

Applicants request a new, clearly labeled copy of each of the references listed above as well as clarification of the above described issues related to each references effective date. Applicants also note that there are three documents received from the USPTO that could not be matched with any of the documents listed in the Notice of References Cited (Form PTO-892). The first has four pages of screen shots but no identifying information whatsoever other than a portion of a first page of a patent application (entitled "Information Record Medium and Apparatus for Recording the Same") appearing in a window in the right upper quarter of each page. The first page seems to be the same as the third page and the second page seems to be the same as the fourth page. The second seems is also a four page document of screen shots where the first page has a Post-It note labeled "1st message 1 correspondence" on it and in the right half of the first page is a window showing a claim 1 and a portion of a claim 2 of a patent application. The third document is an article entitled "A Patent Search and Classification System" by Leah S. Larkey. Applicants presume these documents have been considered by the Examiner even though they did not appear on the Notice of References Cited (Form PTO-892) list.

The Rejections Under 35 U.S.C. § 103(a)

Independent Claims 1, 13, 20, 32 and 33:

Independent claims 1, 13, 20, 32 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Office, Annual Technical Report (herein after WIPO) and "A Java Application Framework for Support Staff and epoline" (hereinafter MADRAS).

This rejection is traversed because the Examiner has not established a *prima facie* case of obviousness for any of these claims.

Claim 1

Claim 1 recites, among other elements, a graphical user interface comprising first and second display sections where the first display section displays a plurality of first file links selectable by a user, each of said first file links providing access to a patent document that was filed in or sent from a patent office and that is stored on a computer-readable medium in an image file format, and the second display section displays a plurality of second file links selectable by the user, each of said second file links providing access to a patent file that is associated with an application program and stored on a computer-readable medium.

According to the Examiner, "WIPO teaches a system referred to as PHOENIX which was developed to completely remove all papers files and replace them with electronic versions, containing all data normally found in the paper folders, WIPO teaches the system managing incoming files (similar to the first display section of the applicant), on page 32, item 5, paragraph 1, and being able to view the specific document, on page 32, item 5, paragraph 1, he further teaches that these item are related to the items in a paper folder, i.e. related to the case, on page 32, item 5, paragraph 1. MADRAS further describes the environment in which PHOENIX is used in, when they teach MADRAS being used as a user interface used for accessing the PHOENIX database (see page 2). It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO and MADRAS before him at the time the invention was made to modify the system of obtaining electronic version of patent documents of WIPO to include the MADRAS interface as did MADRAS. One would have been motivated to make such a combination because MADRAS provides an intuitive interface to the PHOENIX database and is known to be the primary means of accessing data in a PHOENIX."

Applicants have carefully read the Examiner's assertion and respectfully assert that a *prima facie* case of obviousness has not been established. Specifically, the Examiner has not established what in the cited references teaches or suggests the second display section as recited in claim 1 of the present application. No discussion of what in the cited references teaches or suggests the claimed second display section is set forth anywhere in the Office Action. For at least this reason alone, Applicants respectfully assert that the Rejection of claim 1 is improper and that it be withdrawn. If the Examiner disagrees, it is respectfully requested that

the Examiner specifically point out what in either the WIPO or MADRAS references is equivalent to or suggestive of the claimed second display section.

Applicants also respectfully asserts that the Examiner has not clearly articulated what in the cited references is similar to or suggests "a first display section in which is displayed a plurality of first file links selectable by said user" as recited in claim 1. Page 3 of the Office Action states that "WIPO teaches the system managing incoming files" which the Office Action states to be "similar to the first display section". No explanation of the alleged similarity is given however. The teaching in WIPO that a system called PHOENIX was developed to replace "paper files with electronic versions containing all the data normally found in or on the paper folders" is entirely insufficient to assert that the reference teaches the claimed first display section. No details whatsoever are provided in WIPO as to how such information is presented to a user via a graphical user interface (GUI) and no particular GUI is described, yet alone a GUI that includes a first display section having a plurality of first file links selectable by said user as recited in claim 1. If the Examiner disagrees, it is respectfully requested that the Examiner specifically point out what in either the WIPO or MADRAS references is equivalent to or suggestive of the claimed first display section.

To the extent that the Examiner may be asserting that the MADRAS reference teaches or suggests not only a particular GUI but aspects of the claimed GUI including the claimed first and second display sections, Applicants note that the MADRAS reference does not include any screen shots showing particular display sections, includes no detailed description of particular display sections in its user interface or the contents of such display sections and includes only vague references (e.g., "The MADRAS user interface is responsible for managing the windows that the components use for display such as in pages of a notepad, floating windows or independent windows. The MADRAS GUI also provides the links between the components such as menu bars, buttons and inter-process communication.") to the existence of a GUI at all. Accordingly, for at least this additional reason alone, Applicants respectfully asserts that the Rejection of claim 1 is improper and that it be withdrawn.

Claim 13

Claim 13 recites, among other elements, "A method of providing access to information pertaining to a patent application, comprising ... accessing said computer-readable medium with a computer processor and using said computer processor to generate on a display at least first, second and third separate sections wherein in said first section is displayed a list of

said correspondence, in said second section is displayed a list of said patent documents and in said third section is displayed a list of said patent files.

As explained above with respect to claim 1, the combination of WIPO and MADRAS does not teach any specific GUI. Thus, Applicants respectfully assert that the combination of WIPO and MADRAS does not teach the generation on a display of the first, second and third display sections as recited in claim 13 and that the Examiner has failed to establish a *prima facie* case of obviousness of claim 13. Accordingly, Applicants respectfully request the withdrawal of the pending rejection and the allowance of claim 13. If the Examiner disagrees, it is respectfully requested that he specifically point out where in the cited references each of the first, second and third display sections as recited in claim 13 are taught or suggested.

Claim 20

Claim 20 recites, among other elements, "A method of providing access to information pertaining to a patent application, comprising generating a web page from said server system, said web page including at least first, second and third separate sections wherein said first section comprises file links to said correspondence, said second section comprises file links to said patent documents and said third section comprises file links to said patent files

As explained above with respect to claim 1, the combination of WIPO and MADRAS does not teach any specific GUI. Thus, Applicants respectfully assert that the combination of WIPO and MADRAS does not teach the generation of a web page comprising first, second and third separate sections as recited in claim 20 and that the Examiner has failed to establish a *prima facie* case of obviousness of claim 20. Accordingly, Applicants respectfully request the withdrawal of the pending rejection and the allowance of claim 20. If the Examiner disagrees, it is respectfully requested that he specifically point out where in the cited references each of the first, second and third display sections as recited in claim 20 are taught or suggested.

Claim 32

Claim 32 recites, among other elements, a server system comprising a processor operatively programmed to "generate a graphical user interface that can be displayed on a display ..., said graphical user interface including at least first, second and third separate sections wherein said first section comprises a list of said correspondence, said second section comprises a list of said patent documents and said third section comprises a list of said patent files".

As explained above with respect to claim 1, the combination of WIPO and MADRAS does not teach any specific GUI. Thus, Applicants respectfully assert that the

combination of WIPO and MADRAS does not teach the generation on a display of the first, second and third display sections as recited in claim 32 and that the Examiner has failed to establish a *prima facie* case of obviousness of claim 32. Accordingly, Applicants respectfully request the withdrawal of the pending rejection and the allowance of claim 32. If the Examiner disagrees, it is respectfully requested that he specifically point out where in the cited references each of the first, second and third display sections as recited in claim 32 are taught or suggested.

Claim 33

Claim 33 recites, among other elements, a server system comprising a processor operatively programmed to "generate a graphical user interface that can be displayed on a client system display ..., said graphical user interface including at least first, second and third separate sections wherein said first section comprises a list of said correspondence, said second section comprises a list of said patent documents and said third section comprises a list of said patent files".

As explained above with respect to claim 1, the combination of WIPO and MADRAS does not teach any specific GUI. Thus, Applicants respectfully assert that the combination of WIPO and MADRAS does not teach the generation on a display of the first, second and third display sections as recited in claim 33 and that the Examiner has failed to establish a *prima facie* case of obviousness of claim 32. Accordingly, Applicants respectfully request the withdrawal of the pending rejection and the allowance of claim 33. If the Examiner disagrees, it is respectfully requested that he specifically point out where in the cited references each of the first, second and third display sections as recited in claim 33 are taught or suggested.

Comments on Selected Dependent Claims:

Each of the claims dependent on independent claims 1, 13, 20, 32 and 33 stands rejected under 35 U.S.C. 103(a) as being unpatentable over either the combination of the WIPO and MADRAS references alone or the combination of WIPO, MADRAS and either USPTO, EAST or USPTO, WEST. Applicants respectfully assert that each of the claims dependent on one of independent claims 1, 13, 20, 32 and 33 is patentable for at least the same reasons set forth above with respect to the respective independent claims. Nevertheless, Applicants include comments below on selected independent claims pointing out additional reasons of patentability.

Claims 2, 14 and 21 - Applicants note that claim 1 specifically recites that the patent documents accessible via the first file links in the first display section are documents in an

image file format while claim 2 specifies that the patent files accessible via the second file links in the second display section are stored in their native format (e.g., a word processor file stored in MS Word or Word Perfect format). Even assuming *arguendo* that WIPO teaches viewing image files on remote client systems this is not equivalent or suggestive of accessing files stored in an image file format via links in a first display section and accessing files stored in their native format via links in a second display section as required by claims 2 and 21.

Claim 3 - claim 3 requires that at least one of the image files accessible via a link in the first display section correspond to a document stored in its native format accessible via a link in the second display section. An illustrative example of such may be providing a link to a .pdf file of a patent application in the first display section and providing a like to the same patent application (different file) in MS Word format in the second display section. WIPO does not teach or suggest anything similar to or suggestive of this.

Claim 4 - claim 4 recites a third display section that displays a plurality of links providing access to correspondence. As stated above with respect to claims 13, 20, 32 and 33, the combination of WIPO and MADRAS does not teach any specific GUI. Thus, Applicants respectfully assert that the combination of WIPO and MADRAS does not teach the generation on a display of the third display sections in addition to the claimed first and second display sections as recited in claim 4 and that the Examiner has failed to establish a *prima facie* case of obviousness of claim 4 for this additional reason.

Claims 5, 6-7, 18 and 29 - page 4 of the Office Action states "WIPO teaches on pages 32-33, the user accessing either the group of documents (a folder, as in a specific mailing), or the link to the actual document over the web.". Applicants cannot find any indication of such teaching in WIPO and respectfully request clarification of the particular text/section of the WIPO reference on pages 32-33 that is believed to teach such. Furthermore, with respect to claim 6-7, even assuming *arguendo* that MADRAS teaches the use of panels in an interface environment, there is no teaching or suggestion in MADRAS of the specific panel configurations recited in each of these claims.

Claims 8 and 27 - Applicants note that the Office Action does not set forth any basis for maintaining a rejection of these claims. Accordingly, no *prima facie* case of obviousness has been established for these claims for at least this additional reason and the claims are believed to be in condition for allowance.

Claim 9 - claim 9 recites that the second display section includes a plurality of fourth file links in addition to the plurality of second file links where the fourth file links provide access to a prior art documents. The Examiner acknowledges that neither the WIPO or MADRAS references teaches or suggests such a limitation but asserts that the USPTO, EAST reference makes up for this deficiency. As an initial matter and as mentioned above under the Formal Matters heading, (i) Applicants have not been provided with sufficient detail to determine if the USPTO, EAST document is prior art to the present invention and (ii) Applicants are unsure of the pagination of the USPTO, EAST document since pages 1 and 2 seem to be identical.

Applicants have reviewed the four pages of screen shots of the USPTO, EAST document, however, and respectfully assert that they are not at all suggestive to a person of skill in the art of the deficiency noted by the Examiner in the WIPO and MADRAS references. First, Applicants note that the claimed fourth file links in the second display section provide access to documents that are prior art to the same patent application for which the first and second display sections each include links to patent documents and patent files for. To the extent that the html tab in USPTO, EAST 1 does indeed provide links to additional documents (and Applicants respectfully assert that insufficient information has been provided by the Examiner to determine if such is indeed true), there is no indication that the documents are prior art references to a particular patent application for which other documents accessible via links in the second display section are associated with. Second, the Office Action states "It would have been obvious to one of ordinary skill in the art, having the teachings of WIPO, MADRAS, and EAST before him at the time the invention was made to modify the interfaces of WIPO and MADRAS to include these prior art links in the document.". As noted above, the WIPO and MADRAS references do not teach any particular GUI so the Applicants have a difficult time understanding how a person of skill in the art can modify such non-existent GUIs to come up with the invention of claim 9 as the Examiner seems to believe. If the Examiner disagrees, Applicants respectfully request that the Examiner more specifically point out what in the hypothetical WIPO, MADRAS and USPTO, EAST combination pertains to each of the claimed first, second, third display sections as well as the first, second, third and fourth file links included in the respective sections as recited in claim 9.

Claim 15 - claim 15 recites that the generation of a fourth display section that includes a plurality of fourth file links that includes summary information related to the patent

application for which documents and files are stored in the first, second and third display sections. The Examiner acknowledges that neither the WIPO or MADRAS references teaches or suggests such a limitation but asserts that the USPTO, WEST reference makes up for this deficiency. As an initial matter and as mentioned above under the Formal Matters heading, Applicants have not been provided with sufficient detail to determine if the USPTO, WEST document is prior art to the present invention. Clarification is requested.

Furthermore, Applicants have reviewed the two pages of screen shots in the USPTO, WEST document and fail to see how they are at all suggestive to a person of skill in the art of the deficiency noted by the Examiner in the WIPO and MADRAS references. The Office Action states based on the left hand column of the figure WEST 1, the claimed summary information is obvious to a person of skill in the art. The summary information in the left hand column, however, seems to be summary information for a plurality of different granted patents and there is no indication as to how such summary information relates to the other information in the other windows or display sections in the figure. In contrast, the claimed summary information is for a patent application for which image files and documents related to the same are accessible via links listed in display sections also included in the claimed GUI. The USPTO, WEST reference is not suggestive in any manner of such an element and thus, Applicants respectfully assert the USPTO, WEST reference does not make up for this deficiency of the other references and that claim 15 is allowable over the cited prior art for at least this additional reason. If the Examiner disagrees, Applicants respectfully request that the Examiner more specifically point out what in the hypothetical WIPO, MADRAS and USPTO, WEST combination pertains to each of the claimed first, second, third and fourth display sections as recited in claim 9.

CONCLUSION

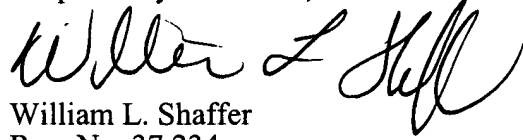
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/919,764
Amdt. dated **January 26, 2005**
Reply to Office Action of July 26, 2004

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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